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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,195	06/13/2001	Kelvin Brian Dickinson	J3544(C)	6049

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UNILEVER
PATENT DEPARTMENT
45 RIVER ROAD
EDGEWATER, NJ 07020

EXAMINER	
GOLLAMUDI, SHARMILA S	
ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/880,195	DICKINSON ET AL.	
	Examiner	Art Unit	
	Sharmila S. Gollamudi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,7 and 13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,7 and 13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of Amendments and Remarks received on May 27, 2004 is acknowledged. Claims **1, 7, and 13** are pending in this application. Claims 2-6 and 8-12 stand cancelled.

Claim Rejections - 35 USC § 102

Rejection of claim 13 under 35 U.S.C. 102(b) as being anticipated by Kawasaki et al (5,556,970) is withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 7, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0546235 by itself.

EP teaches a hair-restorer containing a mixture of castor oil, almond oil, olive oil, and coconut oil in equal proportions for application to the scalp. Glycerol or paraffin oil may be

added. See abstract and page 5. The example teaches 1/6 parts of each castor oil, almond oil, olive oil, coconut oil, glycerol, and paraffin (liquid paraffin or Vaseline oil). Thus, the composition contains 64% of vegetable oils. The criticality of the invention lies in the fact that at least three vegetable oils are utilized with the preference to coconut oil, olive oil, castor oil, and almond oil. EP teaches the use of the vegetable oils lies in the fact that vegetable oils are fatty acid glycerol esters. See page 3.

Note that firstly liquid paraffin is another name for mineral oil, which has 10 to 18 carbons and light oils (hydrocarbons) are considered to have C12 to C20. Therefore, EP implicitly teaches a light mineral oil. Note the art of interest: Grant & Hackh's Chemical Dictionary, Fifth Edition, 1987, pages 422 and 436. Furthermore, since the prior art teaches a light mineral oil, it is the examiner's position that it would implicitly have the same viscosity.

Although EP teaches 16% of paraffin oil, it does not teach the instant lower limit of 20% paraffin oil.

It is deemed obvious to one of ordinary skill in the art at the time the invention was made to look to the prior art conditions, which teaches 16% liquid paraffin, and manipulate its concentration. One would do so as part of the routine experimentation done in the art to optimize and further modify the prior art's composition. Furthermore, differences in concentrations does not support patentability of subject matter encompassed by the prior art

In regards to claim 1 recitation of '60-80% of an oil selected from coconut oil, sunflower oil, and almond oil, and mixtures thereof", although EP teaches only 48% of the instant oils, EP also teaches an additional vegetable oil, i.e. castor oil, to yield the percent of 64%. Although castor oil is not part of the Markush group, it is the examiner's position that the selection of

vegetable oils is an obvious parameter since EP clearly teaches the criticality lies in the fact that the composition contains vegetable oils and castor oil is categorized as a vegetable oil in the art.

Response to Arguments

Applicant argues that EP does not disclose light paraffin oil. Applicant argues that the example only teach 16.7% paraffin and not the required 20%.

Applicant's arguments have been fully considered but they are not persuasive. Firstly, the examiner stands corrected; the liquid paraffin taught in EP is considered light mineral oil in the art. The examiner has supplied the art of interest, Grant & Hackh's Chemical Dictionary, Fifth Edition, 1987, pages 422 and 435-436, to support this argument. Light hydrocarbons oils are categorized has having 10 to 18 carbons and liquid paraffin has 10 to 18 carbons Therefore, EP implicitly teaches a light mineral oil.

Secondly, the applicant should note that the claims are rejected under obviousness and not anticipation, thus it is the examiner's position that EP's concentrations can be manipulated. Further, it should be noted that examples or preferred embodiments are not a teaching away form the broader or obvious disclosure. See *In re Susi.*

Claims 1, 7, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0546235 in view of US patent 5,567,426 to Nadaud et al

EP teaches a hair-restorer containing a mixture of castor oil, almond oil, olive oil, and coconut oil in equal proportions for application to the scalp. Glycerol or paraffin oil may be added. See abstract and page 5. The example teaches 1/6 parts of each castor oil, almond oil, olive oil, coconut oil, glycerol, and paraffin (liquid paraffin or Vaseline oil). Thus, the composition contains 64% of vegetable oils. The criticality of the invention lies in the fact that at

least three vegetable oils are utilized with the preference to coconut oil, olive oil, castor oil, and almond oil. EP teaches the use of the vegetable oils lies in the fact that vegetable oils are fatty acid glycerol esters. See page 3.

Note that firstly liquid paraffin is another name for mineral oil, which has 10 to 18 carbons and light oils (hydrocarbons) are considered to have C12 to C20. Therefore, EP implicitly teaches a light mineral oil. Note the art of interest: Grant & Hackh's Chemical Dictionary, Fifth Edition, 1987, pages 422 and 436. Furthermore, since the prior art teaches a light mineral oil, it is the examiner's position that it would implicitly have the same viscosity.

Although EP teaches collectively 64% of vegetable oils, the said range of EP is not made up of the instant vegetable oils. EP teaches the use of castor oil instead of instant sunflower oil.

Nadaud et al teach a cosmetic composition for the skin and hair. See abstract. The reference teaches the oils may be chosen from vegetable oils such as almond oil, olive oil, castor oil, coconut oil, sunflower oil, etc. See column 6, lines 20-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made and look to the teachings of Nadaud et al and substitute EP's castor oil for instant sunflower oil. One would be motivated to do so since Nadaud teaches the instant oils and castor oils are all vegetable oils. Furthermore, EP clearly teaches the criticality lies in the fact that the composition contains vegetable oils. Therefore, it is prima facie obvious to substitute one equivalent for another with the expectation of similar results and success since the prior art establishes the functional equivalency of the castor oil and instant sunflower oil.

Claims 1 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 4,488,564 to Grollier et al.

Grollier et al teach an oily composition intended for the treatment of keratin substances, in particular the treatment of human hair and skin. More specifically, the treatment is for dried out hair that has been exposed to external elements. See abstract and column 1, lines 5-10. The oily compounds are chosen from Vaseline oil (liquid petrolatum), animal oils, and vegetable oils such as castor oil, olive oil, avocado oil, etc. See column 2, lines 20-40. A particularly preferred composition contains 30-100% Vaseline oil and 0-70% vegetable oil. Example 1 discloses a hair composition containing 15g texapon, 25g (17%) Vaseline oil, 3g of a polymer, 100g (69.9%) olive oil, and antioxidants, and perfumes. The composition is applied to the hair to add softness.

Although Grollier teaches 17% of Vaseline oil, Grollier does not teach the instant lower limit of 20%. Further, Grollier does not teach the viscosity of the Vaseline oil.

It is deemed obvious to one of ordinary skill in the art at the time the invention was made to look to the guidance provided by Grollier et al and manipulate the concentrations of the oil components as a part of the optimization process done through routine experimentation. Furthermore, one would be motivated to do so since Grollier et al teach the manipulation of the oil compound in the composition can vary wherein the Vaseline oil may be utilized from 30% to 100% and the vegetable oil may be varied from 0 to 70%. Thus, the differences in concentrations does not support patentability of subject matter encompassed by the prior art.

Further, it is deemed obvious to one of ordinary skill in the art at the time the invention was made to look to the guidance provided by Grollier et al and utilize light paraffin oil. One would be motivated to do so depending on the desired viscosity of the product since it is known in the cosmetic art that light paraffin oil is less viscous than heavy paraffin oil. Therefore, it is

prima facie obvious to utilize a heavy or light paraffin accordingly since they are conventional hydrocarbons used in the hair art.

Lastly, in regards to the consisting essentially of language, the instant claim language does not exclude the Grollier's polymer or surfactant since these ingredients do not affect the basic and novel characteristics of the instant invention. This is substantiated by instant specification page 7 wherein applicant states that the formulation can contains conventional hair additives including water-soluble compounds, active agents, colorants, etc.

Art of Interest

Grant & Hackh's Chemical Dictionary, Fifth Edition, 1987, pages 422 and 435-436.

GB 824,353 to Irma Andersin is cited as art of interest since Andersin discloses the state of the art. Andersin states, "It is well known to add to hair oils, which are composed essentially of mineral and/or vegetable oil including petroleum oils, olive oil, almond oil, and castor oil."

Conclusion

No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharmila S. Gollamudi
Examiner
Art Unit 1616

SSG

MICHAEL G. HARTLEY
PRIMARY EXAMINER